

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Double Patenting

Claims 1 to 48 are provisionally rejected on the ground of nonstatutory double patenting rejection as being unpatentable over claims 1 to 48 of co-pending application 10/757,660. The Applicants note however that application no. 10/757,660 pertains to a different applicant. No reply was received to our email to Examiner Frech dated January 11, 2005. There is no terminal disclaimer enclosed in view of application no. 10/757,660. Applicant respectfully requests correction to error.

Claim Rejections – 35 USC § 103

At page 3 of the Office Action, the Examiner rejects claims 1 to 48 as being unpatentable over 4,724,309 (US Patent No. 4,724,309).

Claims 1 and 29 have been amended to clarify that the sensing device senses at least some of the coded data, and generates, using the at least some of the coded data, the indicating data. Claims 4 and 32 have also been amended to specify sensing at least some of the coded data and generating the data regarding said at least one parameter using the at least some of the coded data and generating its own movement relative to the form. Support for these amendments can be found at line 5 of page 29 to line 12 of page 31.

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

The MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Greene fails to fairly teach or suggest the claim limitation of claim 1 of "*receiving, in a computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, sensing at least some of the coded data, and generating the indicating data using the at least some of the coded data*". Nothing is Greene teaches or suggests that the computer system receives any data indicative of the position of the sensing device.

Based on the disclosure of Greene, the scanner and optical reader could sense pre-encoded areas indicative of a bank-ID number, the account number, the check sequence number, and the amount already encoded along the bottom edge of the document. Based on the disclosure of Greene, this data could be received by a computer system from the scanner and optical reader.

However, nothing in Greene suggests that the computer system could receive data from the sensing device indicative of a position of the sensing device relative to the form, when the sensing device is placed in an operative position relative to the form to sense at least some of the coded data and generate the indicating data based on the at least some of the coded data. Furthermore, nothing in Greene fairly teaches or suggests that the computer system identifies from the indicating data (which represents the position of the sensing device to the form), at least one parameter relating to the listing search transaction.

As all the claim limitations have not been fairly taught or suggested based on the disclosure in Greene, the Applicant respectfully submits that the third basic requirement of a prima facie case of obviousness has not been met to reject the claims as unpatentable, as per MPEP §2143.

Furthermore, the Applicant notes that further patentable subject matter exists in dependent claims. In particular claims 3 and 4, wherein the sensing device generates data indicative of the movement of the sensing device relative to the form. Nothing in Greene fairly teaches or suggests that the computer system receives data indicative of the movement of the sensing device relative to the form, and the computer system interprets the movement of the sensing device as it relates to the at least one parameter.

Additionally, nothing in Greene fairly teaches or suggests the claim limitation of claim 5 wherein the computer system receives from the sensing device data indicative of the identity of the user.

The above arguments also similarly apply to corresponding system claims.

Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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